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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER MOSSER, ROBERT E				
ART UNIT		PAPER NUMBER		
3714		13		
DATE MAILED: 03/31/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,605

Applicant(s)

PAU ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

In response to the amendment filed September 12, 2003 claims 1 through 4 and 6 through 18 are pending.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4, 6-9, 12, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573).

Regarding claim 1, O'Halloran teaches a gaming machine with display means (Element 20) and control means (Element 32) being disposed to play an underlying game with underlying prizes associated with the underlying game (See Figure 2) wherein on the occurrence of a predefined event or triggering event (See Col 1:49) the player is enters a second game in which a common game type with two or more game choices is provided (See Col 1:50-51 & Col 2:12-24). O'halloran further discloses the second game in which the player selects a card from a row of cards and where further the chance of the player selecting a card that would yield a winning out come is inversely proportional to the number of card per the row selected thus indicating a random assignment of the winning card as so claimed (See Col 2:16-24 & Figures 4 and 5),

O'Halloran further teaches allowing the player to choose only one prize set as so claimed in the players selection of the eight of spades second set in Figure 5 for example. The previous selection made immediately following the start off the bonus round results in the selection of one prize set and a selection of a non-winning outcomes or equivalently elements (*Eight of spades shown in figure 5 & Col 3:66-4:3*) that in turn ends the bonus game, wherein as understood the bonus game only continues upon a win in the bonus game (Col 3:62-65).

The claimed "total theoretical return to the player is the same regardless of the prize the player chooses" is an inherent feature of gaming devices in that a fixed total theoretical return is required by gaming law or gaming regulations as per the applicants arguments on page 6 of paper 11.

O'Halloran is silent on including bonus game prizes that are independent of the prize awarded in the underlying game and the displaying of at least two winning outcomes within at least one of the prize sets.

Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set size of multiple winning outcomes and a non-winning outcome that further spin randomly before stopping on a segment so as to define a prize won, which is independent of any prize awarded in the underlying game and upon defining the prize won the several other possible prize outcomes are displayed to the user (See Figures 4 & 6).

It would have been obvious to one of ordinary skill in the art at the time of invention to included prizes that are independent of the prize awarded in the underlying game of O'Halloran and the displaying at least two winning outcomes within at least one of the prize sets thereof, in light of the teachings of Baerlocher et al, in order to avoid player perception of being penalized for getting a bonus event on a small win in the underlying game or alternatively give the player the perception of a greater amount of total prize possibilities in a similar fashion to the spinning of the reels of a traditional slot machine.

Regarding Claims 2-4 and in addition to the above stated. O'Halloran teaches one winning outcome or the Joker card being presented per row or prize set and at least one non-winning outcome being presented per row or prize set (See Figure 5). This corresponds to one or more prize outcomes, which are identical in the same prize set or in a different prize set (See the middle and bottom rows of cards in figure 5) where in the identical prize outcomes are the non-winning outcomes represented via the non-Joker type playing cards.

Regarding claim 17 and in addition to the above stated. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set size and spin randomly before stopping on a segment that defines a prize won (See Figures 4 & 6).

Regarding claims 6-8 and in addition to the above stated. O'Halloran teaches the use of a combination of symbols appearing on the win lines of a spinning reel game of chance for the purposes of triggering a game feature (See Col 3:15-21). This corresponds to the occurrence of a special combination in claim 6 as presented, the triggering of a game feature (triggering event as so claimed) at random in claim 7 as presented where in the random triggering is due to the random alignment of the trigger event or winning combination on a reel game, and a spinning reel game as presented in claim 8 (See Figure 2).

Regarding claim 12 and in addition to the above stated. O'Halloran teaches the presentation of each prize set distinctly as each prize set as so claimed is presented herein as a row of cards (See Figures 4 and 5).

Regarding claims 9, and 14-16 and in addition to the above stated. O'Halloran teaches the presentation of player selectable prize sets that includes: winning and non-winning outcomes and identical prize outcomes located between sets and located within the same prize set but is silent on the use of segments on a spinning wheel to define the prize outcome. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that spin randomly before stopping on a segment that defines a prize outcome won by the player (See Figure 6). It would have been obvious to have

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incorporated the multiple spinning wheels or simulations thereof that spin randomly before stopping on a segment that defines a prize outcome as taught by Baerlocher et al in the invention of O'Halloran in order to suit the theme of the bonus game being played or adapt an existing bonus game to a machine with a wheel theme.

3. Claims 10, 11, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573) in further view of DeMar et al (US Pat 6,315,660).

The combination as taught by O'Halloran/Baerlocher et al taught above is silent regarding the use of dice as the three dimensional object and the use of a board game representations as so claimed. DeMar et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates a board game feature (Element 62) wherein a random role of dice (Element 64) or simulation thereof (Element 43) determine the distance traveled on the board and the prize outcome (See Figures 1,6,8,13,16B, and 24). Further as presented in at least claim 11 the prizes defining the faces of the dice corresponds to the number shown on the dice of DeMar and corresponding prize associated with the resultant board position of the player piece/game token combined with the display of the prize values that define segments of a wheel as presented in Baerlocher et al and shown above.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of dice as the three dimensional object in game representation in the game as taught by O'Halloran/Baerlocher, in light of the

teachings of DeMar et al, in order to extend the period of player anticipation through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.

Response to Arguments

Applicant's arguments filed 2-04-2004 have been fully considered but they are not persuasive.

Remarks directed towards the claimed feature of the player's ability to control "volatility" are present in the game O'Halloran as set forth above in at least as much as they are presently claimed.

Remarks directed to the equating of the game of O'Halloran to a simple "double up" feature is in contra to the teaching of O'Halloran wherein O'Halloran teaches the "double up" as being that of a typically binary selection (Col 1:19-21). As the game of O'Halloran contains more than two distinct selection as apparent from figure 5 in the second and third row of selections, this equation is not truly fitting. Further support for this is evident in that the game of O'Halloran allows the player to select their odds (by choosing the row) for the selection where as any "double up" games of a binary format would in turn require multiple selections in some cases while being impossible to replicate in other cases (i.e. the line containing a 1/3 probability of winning). Thus as disclosed allowing the player to select their odds for a single selection presents at least one true distinction between the game of O'Halloran and the "double up" game.

Regarding the arguments directed towards the only similarities between O'Halloran and Baerlocher. Both of the inventions relate to electronic gaming machines as stated as well as embodiments of electronic bonus games as so claimed. Both inventions provide a bonus feature wherein the player stands the greater chance of obtaining a smaller win rather than an exceptionally large one. This is evident in the wheel of Baerlocher where only one bonus symbol is shown respective to 24 total symbols (Fig 5 Baerlocher) and the diminishing odds with the increase of prize amount in O'Halloran as shown in at least figure 4.

Regarding the theoretical return of the invention of O'Halloran. If the user were allowed to participate in the bonus round freely without having to qualify first and/or capable of wagering more than their winnings in the base game then the theoretical return of the game would be 100% as the player could double their bets to cover their losses. However O'Halloran requires the player to qualify and only teaches continuation of the bonus round on successive wins as taught in the rejection above. This results in standard diminishing odds (Variable) for each successive round that the user is capable of playing in a bonus game and dependent on the combination of odd(s) chosen per selection. Thus the operation of the game of O'Halloran does not teach a 100% theoretical returns and does effect the calculation of the over all theoretical return to the player.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both inventions relate to the same field of invention specifically electronic bonus gaming wherein the over all theoretical return is clearly effected by the bonus game outcome.

Further the combination as presented above teaches the use of fixed prizes and the use of wheels of fixed sizes as taught by Baerlocher et al. The inclusion of allowing the player to view the prizes apparent on each wheel prior to selection to this point has not relied upon and as such it may be assumed that the symbols remain hidden until selection as taught by O'Halloran. Further even in the case where the indicia on the wheel may be shown the invention of Baerlocher teaches altering the number of symbols displayed on a wheel with a fixed element size (Col 7:9-29) and the altering of individual selection odds for a fixed element/fixed symbol size set (Col 6:39-67 & Fig 5), either of which may be used to readily compensate for allowing the player to select the wheels if not spun in a hierarchical fashion. For the reasons set forth above the rejections are maintained.

Conclusion

4. This is a continuation of applicant's earlier Application No. 09/965605. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had

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been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM


JESSICA HARRISON
PRIMARY EXAMINER